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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,242

04/23/2004

Jeffrey Kaplan

10853.3801

3241

22235 7590 03/17/2008
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

HUYNH, KHOA D

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,242	Applicant(s) KAPLAN, JEFFREY	
	Examiner Khoa D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I in the reply filed on 01/17/2008 is acknowledged.

Applicant in the reply indicates that claims 1-15 and 18 are readable on the elected Species 1. Accordingly, claims 16, 17, 19 and 20 are withdrawn from further consideration as being drawn to the non-elected invention.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for retaining includes at least one rib and the at least one depression at least partway through the top surface as recited in claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are also objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "18" has been used to designate both "a top surface" and "protruding ribs" (specification, paragraph [0033]).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: at least one depression at least partway through the top surface as recited in claim 10.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the inner retainer". There is insufficient antecedent basis for this limitation in the claim and therefore, render the claim indefinite. Claims 4-6 depend from claim 3 and are likewise indefinite.

Claim 5 recites the limitation "the outer cylinder". There is insufficient antecedent basis for this limitation in the claim and therefore, render the claim indefinite. Claim 6 depends from claim 5 and is likewise indefinite.

Claim 10 recites "at least one depression at least partway through the top surface". Such recitations render the claim indefinite since the claimed subject matter does not have detailed support in the instant specification. Since the claim does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable.

Claim 12 recites the limitation "the means for sealing". There is insufficient antecedent basis for this limitation in the claim and therefore, render the claim indefinite

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 9-15 and 18, as presently understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lombardi et al. (5342134).

Regarding claim 1, the Lombardi et al. reference discloses a styptic pencil dispenser. The dispenser includes a styptic pencil (30) having a pre-determined diameter, and a styptic pencil holder (Fig. 1). The holder includes an annular tubular base (Fig. 8) having cylindrical cavity sized in diameter approximately equal to the styptic pencil diameter to retain the styptic pencil, an inner retainer

sleeve (Fig. 5) having a top end located generally circumferentially around the base. The dispenser also includes a means for adjusting (10, 1) the distance of the base retaining the styptic pencil to the top end of the retainer located at the bottom end of the dispenser allowing the tip only to be exposed for use; and a sealable cap (at 4 and 105 in Fig. 4) sized to fit snug with and over the retaining sleeve to prevent the styptic pencil from moisture and becoming wet during application.

Regarding claim 2, wherein the base has at least one rib (20) for holding the styptic pencil.

Regarding claim 3, wherein the means for adjusting comprises an outer generally cylindrical shell (10 in Fig. 6) located peripherally around the inner retainer sleeve, whereby the inner retainer sleeve is rotatable within the outer shell.

Regarding claim 4, wherein the means for adjusting further comprises a rotatable grip (1), whereby the distance of the base to the inner retainer sleeve is adjusted by the rotation of the grip.

Regarding claims 5 and 6, wherein the base further includes at least one protrusion (16), the inner retainer sleeve includes a vertical slot (14) having a bottom endpoint and a top endpoint, and the outer shell includes at least one helical depression (18) at least partway through the outer shell, whereby the protrusion engages both the slot and the depression and whereby the base is elevated and lowered by movement of the means for adjusting, and wherein the

engagement of the protrusion with the slot and the depression limit the adjustment distance of the base.

Regarding claims 9 and 10, wherein the base includes means for retaining the styptic pencil (Fig. 8), wherein the means for retaining includes at least one rib (20) for engagement with the styptic pencil, and at least one depression (constituted by the portion between the ribs 20) at least partway through the top surface.

Regarding claims 11 and 12, the cap further comprises a means for sealing moisture or wetness from the styptic pencil, wherein the means for sealing comprises at least one annular seal (at 112).

Regarding claim 13, wherein the cap is inherently frictionally engaged with the means for adjusting, whereby the styptic pencil is protected from moisture.

Regarding claim 14, wherein the tolerance of the fit of the cap inherently enhances the protection of the styptic pencil against moisture.

Regarding claim 15, the dispenser further comprises protrusions (112,108) for engagement with the cap whereby exposure of the styptic pencil to moisture is inherently decreased when the cap is in place.

Claim 18 recites limitations that substantially similar to the limitations recited in claim 1 which has been rejected as discussed supra.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3751

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lombardi et al. (as discussed supra).

Even though the Lombardi et al. reference does not specifically disclose that the styptic pencil comprises water soluble resin, polyethylene glycol and glycerine as claimed, it, however, would have been obvious to one of ordinary skill in the art to employ such components for the styptic pencil or lipstick composition. Such modification would be considered a mere choice of a preferred components for the styptic pencil or lipstick composition that is suitable with cosmetic products, especially since the Lombardi et al. reference also discloses that the composition include de various water soluble components, single of mixtures of oils, and emulsifier (col. 3, lines 1-35). In other words, the use of a specific components for making the styptic pencil or lipstick would have been an “obvious to try” approach since the use of water soluble resin, polyethylene glycol and glycerine to form a cosmetic composition is not of innovation but of ordinary skill and common sense. *KSR, 550 U.S. (2007)*.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khoa D. Huynh/
Primary Examiner, Art Unit 3751